



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,893	02/12/2002	Mikio Watanabe	0905-0271P	3564

2292 7590 07/28/2005

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

NGUYEN, CAO H

ART UNIT	PAPER NUMBER
----------	--------------

2173

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/072,893

Applicant(s)

WATANABE ET AL.

Examiner

Cao (Kevin) Nguyen

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some.* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being obvious over Sato (US Patent No. 6,515,704) in view of Gotanda (US Patent No. 6,707,570).

Regarding claim 1, Sato discloses a system comprising a digital still camera and an image data receiving apparatus, wherein said digital still camera includes: an image sensing device for sensing the image of a subject and outputting main-image data representing the image of the subject (see col. 4, lines 10-30); a recording controller for recording the main-image data output from said image sensing device on a recording medium in association with an identification code that identifies the image of the subject; a thumbnail-image data generating device for generating thumbnail-image data that represents a thumbnail image the amount of data whereof is less than

Art Unit: 2173

that of the image of the subject represented by the main-image data output from and said image sensing device (see col. 4, lines 32-63); a thumbnail-image data transmitting device for transmitting the thumbnail-image data generated by said thumbnail-image data generating device to said image data receiving apparatus in association with the identification code that corresponds to the corresponding image of the subject (see col. 5, lines 10-45); however, Sato fails to explicitly teach said image data receiving apparatus includes an image data receiving device for receiving thumbnail-image data transmitted from said thumbnail-image data generating device of said digital still camera and with which the identification code has been associated; and a display controller for device in such a manner that the controlling a display thumbnail image represented by the thumbnail-image data received by said image data receiving device will be displayed in association with the corresponding identification code.

Gotanda teaches image data receiving apparatus includes an image data receiving device for receiving thumbnail-image data transmitted from said thumbnail-image data generating device of said digital still camera and with which the identification code has been associated; and a display controller for device in such a manner that the controlling a display thumbnail image represented by the thumbnail-image data received by said image data receiving device will be displayed in association with the corresponding identification code (see col. 9, lines 7-60). It would have been obvious to one of an ordinary skill in the art at the time the invention was made to provide a display controller for device in such a manner that the controlling a display thumbnail image represented by the thumbnail-image data received by said image data receiving device will be displayed in association with the corresponding identification code as taught by Gotanda to the sensing display image of Sato in order to enable the user can simultaneously

Art Unit: 2173

recognize the thumbnail image and the user can view all the images by appropriately ID code to operating an index on the display device.

Regarding claim 2, Gotanda discloses data receiving apparatus further includes a code input device; and an output device for reading main-image data, which corresponds to the identification code entered from said identification code input device, from the recording medium and outputting the main-image data (see col. 2, lines 15-63).

Regarding claim 3, Gotanda discloses, wherein said image data receiving apparatus further includes: a user code input device for entering a code that specifies a user; a user code discriminating device for determining whether the user code entered from said user code input device is legitimate; and a printer controller for controlling a printer in such a manner that the image of a subject represented by main-image data output from said output device will be printed in response to a determination by said user code discriminating device that the entered user code is legitimate (see col. 10, lines 3-62).

Claim 4 differs from claim 1 in that “discloses an image sensing device for sensing the image of a subject and outputting main-image data representing the image of the subject; a first recording controller for recording the main-image data output from said image a recording medium in association with sensing device on an identification code that identifies the image of the subject obtained by said image sensing device; a thumbnail-image data generating device for generating thumbnail-image data that represents a thumbnail image the amount of data whereof is less than that of the image of the subject represented by the main-image data output from said image sensing device; and a thumbnail-image data transmitting device for transmitting the

Art Unit: 2173.

thumbnail-image data generated by said thumbnail-image data generating device to an image data receiving apparatus in association with the identification code that corresponds to the corresponding image of the subject. an image sensing device for sensing the image of a and a thumbnail-image data transmitting device for transmitting the thumbnail-image data generated by said thumbnail-image data generating device to an image data receiving apparatus in association with the identification code that corresponds to the corresponding image of the subject.” which read on Sato see col. 6, lines 15-67).

Regarding claim 5, Gotanda discloses an image-sensing controller for allowing succeeding sensing of the image of a subject by said image sensing device in response to completion of recording of the main-image data on the recording medium by said first recording controller and of transmission of the thumbnail-image data by said thumbnail-image data transmitting device (see col. 11, lines 1-45).

Regarding claim 6, Sato discloses said first recording controller recording the main-image data on the recording medium in response to pressing of a shutter-release button; said camera further comprising: a buffer memory for temporarily storing main-image data that is output from said image sensing device; a first discriminating device for determining whether the shutter-release button has been pressed during transmission of thumbnail-image data by said thumbnail-image data transmitting device; a memory controller for controlling said buffer memory in such a manner that main-image data that is output from said image sensing device is stored in said buffer memory temporarily in response to a determination by said first discriminating device that the shutter-release button has been pressed; and a second recording controller for recording the main-image data, which has been stored temporarily in said buffer

Art Unit: 2173

memory, on the recording medium in response to a determination that transmission of thumbnail-image data by said thumbnail-image data has been completed (see col. 4, lines 1-29 and figures 1-3).

As claims 7-12 are analyzed as previously discussed with respect to claims 1-6 above.

Claims 13-14 differ from claims 1 and 4 in that “a method of controlling operation of an image data transmitting apparatus, comprising the steps of receiving data representing an identification code transmitted from an image data receiving apparatus; reading main-image data, which corresponds to an identification code represented by received identification-code data, from a recording medium on which has been recorded the main-image data with which the identification code is associated; and transmitting the read main-image data to said image data receiving apparatus” which read on Gotanda; see col. 12, lines 26-60 and figures 23-25.

Regarding claims 15-16, Gotanda discloses wherein the main-image data is recorded in an image file and the ID code is recorded in a header of the image file (see figure 20).

Regarding claims 17-18, Gotanda discloses wherein the ID code associated with the thumbnail-image data is recorded (see figures 20-21).

As claims 19-24 are analyzed as previously discussed with respect to claims 13-24.

Response to Arguments

Applicant's arguments filed on 02/11/05 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

Art Unit: 2173

obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument on pages 16-17 that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Sato discloses a system comprising a digital still camera and an image data receiving apparatus used in combination of Gotanda's generating device of said digital still camera and with which the identification code has been associated. One skilled in the art would have been obvious to enable the user can simultaneously recognize the thumbnail image and the user can view all the images by appropriately ID code to operating an index on the display device.

On page 17 of the remarks; Applicant argues that the combination of Sato and Gotanda do not teach or suggest "whether thumbnail images are transmitting"; however, the limitation as claimed set forth to broadly read on "A request to insert the recording medium is displayed on the display screen of the display unit. The medium on which the image data has been recorded is inserted into the medium insertion/ejection unit by the user and is then transported to the

Art Unit: 2173

medium reader by the medium transport unit. Image data that has been recorded on the inserted medium is read by the medium reader. The image data that has been read is then stored temporarily in a memory within the data storage unit. The data stored temporarily in the internal memory of the data storage unit is input to the operation/display controller and is applied from the operation/display controller to the display unit. Thumbnail images of the images of the images represented by the image data that has been stored on the medium are displayed in at-a-glance fashion, as shown in FIG. 20. A request to select images to be printed is then made. It goes without saying that the thumbnail-image data has been recorded on the medium in advance. It is of course possible, however, to generate the thumbnail-image data in the central processing unit rather than record this data on the medium; see Gontanda col. 8, lines 25-67.

On page 18 of the remarks; Applicant argues that the combination of Sato and Gontanda do not teach or suggest “an ID data receiving device for receiving an ID code transmitted from an image data receiving apparatus”; however, the limitation as claimed set forth to broadly read on “wherein said image-print ordering apparatus further includes: an identification issuing unit for issuing identification data; and an identification data transmitting unit for transmitting the identification data issued by said identification issuing unit to said image printing apparatus deployed at a destination specified based upon the destination-related information; and said image printing apparatus further includes: an identification data receiving unit for receiving the identification data transmitted from said identification data transmitting unit of said image-print ordering apparatus; a first identification data input unit for inputting identification data; an identification data discriminating unit for determining whether identification data received by said identification receiving unit and identification data input from said first identification input

Art Unit: 2173

unit match; and a second printing control unit for controlling said printing unit so as to print images in response to a determination by said identification data discriminating unit that a match has been obtained; and wherein identification data is readably recorded on the ticket; said identification data issuing unit of said image-print ordering apparatus issues identification data read from the ticket; and said identification data input unit of said image printing apparatus reads identification data from the ticket.” See Gontanda col. 15, lines 47-67.

On page 18 of the remarks; Applicant argues that the combination of Sato and Gontanda do not teach or suggest “data transmitting device from a digital camera with which the ID has been associated”; however, the limitations as claimed set forth to read on “an image-print ordering apparatus comprising: a destination information reading unit for reading destination-related information from a ticket on which the destination-related information has been recorded in a readable manner; an image data reading unit for reading image data that has been recorded on a first portable recording medium; and an image data transmitting unit for transmitting the image data, which has been read by said image data reading unit, to an image printing apparatus deployed at a destination specified based upon the destination-related information read by said destination information reading unit; and an image output apparatus capable of communicating with an image-print ordering apparatus that is for reading destination-related information from a ticket on which the destination-related information has been recorded in a readable manner, and transmitting image data to an image printing apparatus deployed at a destination specified by the read destination-related information, said image output apparatus comprising: an image data receiving unit for receiving image data transmitted from said image data transmitting unit of said image-print ordering apparatus; and an output

Art Unit: 2173

unit for outputting image data received by said image data receiving unit.” see Gontanda col. 16, lines 33-55.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see PTO-892).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

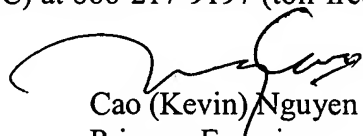
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cao (Kevin) Nguyen whose telephone number is (571)272-4053. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571)272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Art Unit: 2173

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cao (Kevin) Nguyen
Primary Examiner
Art Unit 2173

07/19/05